



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,707	03/10/2004	Fiona Patricia Carney	CL/V-32903A	4227

31781 7590 09/26/2007
CIBA VISION CORPORATION
PATENT DEPARTMENT
11460 JOHNS CREEK PARKWAY
DULUTH, GA 30097-1556

EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
----------	--------------

3736

MAIL DATE	DELIVERY MODE
-----------	---------------

09/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,707	Applicant(s) CARNEY ET AL.	
	Examiner Jeffrey G. Hoekstra	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-18 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 07/16/2007, amended claim(s) 15 and 16, is/are acknowledged. The following new and reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by March (US 2001/0034500 A1).
4. For claim 14, March discloses a kit (paragraph 28) for collecting an analyte of interest in a body fluid, comprising: a contact lens (1) for binding the analyte of interest in a tear fluid (paragraph 1), wherein said contact lens comprises molecular imprints for the analyte of interest (paragraphs 17, 26, and 27), wherein the molecular imprints for the analyte of interest are obtained by curing a polymerizable composition comprising an analyte of interest to form the contact lens (paragraphs 26-27) and then extracting the analyte of interest from the contact lens (paragraphs 19-20 and 26-27).
5. For claim 15, March discloses a kit, wherein the contact lens further comprises surface charges (paragraph 27) which are introduced by: preparing the contact lens from a composition comprising a positively or negatively charged monomer or macromer (paragraph 27); altering the chemical nature of chemical groups on the surface of the contact lens (paragraph 27); and applying a layer by layer (LbL) coating

composed of at least one layer of a polyionic material onto the contact lens (paragraph 27).

6. For claim 16, March discloses a kit, wherein the contact lens has surface charges that are introduced by applying an LbL coating composed of at least one layer of a polyionic material onto the contact lens (paragraph 27).

7. For claim 17, March discloses a kit, wherein the contact lens further comprises a coating comprising a receptor that binds specifically the analyte of interest (paragraph 1 and 4).

8. For claim 18, March discloses a kit, wherein the receptor is selected from the group consisting of at least hormone receptors, drug receptors, and enzymes (paragraph 4).

Response to Arguments

9. Applicant's arguments filed 07/16/2007 have been fully considered but they are not persuasive. Applicant argues the 102(b) rejection of claims 14-18 as being anticipated by March as reiterated above. Specifically Applicant argues March does not disclose or teach (a) "molecular imprints for an analyte of interest distributed within a contact lens" and (b) the formation of molecular imprints in contact lenses "by curing a polymerizable composition comprising an analyte of interest to form the contact lens and then extracting the analyte of interest from the contact lens". The Examiner disagrees, maintains the anticipatory rejection as broadly as claimed, and notes the following:

10. In response to applicant's argument that (a) and (b), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

11. Moreover, in response to Applicant's argument that (a) March does not disclose or teach "molecular imprints for an analyte of interest distributed within a contact lens" and conversely teaches a contact lens having pores sized to permit a competitor moiety to bind reversibly to an analyte/competitor moiety binding site, the Examiner notes as broadly as structurally claimed March discloses a contact lens comprising molecular imprints capable of binding the analyte of interest in a tear fluid (as set forth above).

12. Moreover, in response to Applicant's argument that (b) March does not disclose or teach (b) the formation of molecular imprints in contact lenses "by curing a polymerizable composition comprising an analyte of interest to form the contact lens and then extracting the analyte of interest from the contact lens", the Examiner notes as broadly as structurally claimed March discloses a contact lens comprising molecular imprints capable of binding the analyte of interest in a tear fluid (as set forth above) that is capable of being formed by curing a polymerizable composition comprising an analyte of interest to form the contact lens and then extracting the analyte of interest from the contact lens.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra

Examiner, Art Unit 3736


MAX F. MINDENBURG
SENIOR PATENT EXAMINER
EBC CENTER 3700